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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,671	07/11/2001	Donald Zaff Rogers	DEP05507-RE	5452

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EXAMINER

NAKARANI, DHIRAJLAL S

ART UNIT PAPER NUMBER

1773

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,671

Applicant(s)

ROGERS, DONALD ZAFF

Examiner

D. S. Nakarani

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-28 and 35 – 48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original specification as filed does not provide support for the following limitations:

(1) Claim 1, line 3, the intended use limitation “non-functional ornaments”. The original patent specification neither defines nor discloses “non-functional ornaments. Therefore in absence of disclosure and/or definition it is a new matter.

(2) Claims 13, lines 2-3, and claim 35, lines 3-4, the limitation “at least one curved surface and at least two dimensions of substantially the same proportion “ is not supported by the originally filed patent specification. Patentee has not pointed out where the support for this limitation can be found in the originally filed patent specification.

(3) Claim 17, lines 2-3 and claim 28, lines 3-4, the limitation. “ a substrate having height, width and depth dimensions of substantially the same proportion” is not supported by the originally filed patent specification. The Example 1 and Figure 1 provide support for the substrate composed of cubic zirconium dioxide and formed with cut and polished facets. Thus the final coated articles is not a cube and therefore does not provide support for the above

Art Unit: 1773

limitation since it reads on coated cube that is height, width and depth dimensions of the same proportion.

(4) Claim 22, lines 2-3, the limitation “substrate having a depth dimension of substantially the same proportion as its height or width dimension” is not supported by the originally filed patent specification. The Example 1 and Figure 1 only provide support for the substrate composed of cubic zirconium dioxide and formed with cut and polished facets.

(5) Claim 27, line 2, the limitation “substrate having at least two non parallel curved surfaces” is not supported by the originally filed patent specification. The shape of turtle in Example 2 does not provide support for said limitation. It is only provide support for transparent lead crystal glass in the shape of a turtle.

(6) Claims 40 and 45, lines 2-4, the limitation “at least one curved surface and substantially the same maximum dimension in at least two orthogonal directions” is not support by the originally filed specification.

(7) Claims 44 and 48, lines 2-4, the limitation “with substantially the same maximum dimension in three orthogonal directions and at least one generally circular cross section” not supported by the originally filed specification.

3. Claims 1-16, 27 and 29-39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hettich et al. (U.S. Patent 4,769,290) in view of Austin (U.S. Patent 5,332,618) for the reasons of record set forth in paragraph 2 of the Office Action mailed March 28, 2002 and paragraph 2 of the Office Action mailed October 10, 2002. Further Austin’s corrective spectacles deemed to have at least two non-parallel curved surfaces.

Art Unit: 1773

4. Applicant's arguments filed April 19, 2004 have been fully considered but they are not persuasive. In reference to rejection of claims under 35 USC§ 112, first paragraph applicants mainly argue that the turtle is a non-functional ornaments and in reference to limitations 2-5 in the Office Action not supported by the originally filed specification applicants mainly points to Figs 1-3 and state that turtle provide support for non-parallel surface and cube of Example 1 provide support for other limitations.

These arguments are unpersuasive because turtle has a decorative function. Therefore, it is a functional article. There is no definition of non-functional ornaments provided in the originally filed specification.

In reference to rejection of claims 1- 16, 27 and 29-36 under 35 USC 103 (a) as being unpatentable over Hettich et al (U. S. Patent 4,769,290) in view of Austin (U. S. Patent 5,332,618), applicant mainly continues to argue that Hettich et al's disclosure directed to a high efficiency reflectors and Austin's disclosure is directed to an antireflection layer system. There is no disclosure or suggestion in Hettich et al of coating substrates to form any objects other than high efficiency reflectors. Austin discloses coating sunglasses with an antireflective coating. Applicant also alleges that the Examiner concedes that the motivation is not provided by the cited references and asserts that the motivation may come from knowledge generally available. However the Examiner has not identified the generally available knowledge on which the Examiner relies on or cited any source of such unidentified knowledge.

These arguments are unpersuasive because if Hettich et al's disclosure is limited to only high efficiency reflectors (that is title of the disclosure) and Austin's disclosure is limited to antireflection layer system as argued then the present disclosure also limited to gemstones and

Art Unit: 1773

decorative objects. The invention directed to gemstone is allowed. Hettich et al teach transmitting selected wavelength of light and reflecting selected wavelength of light. Austin also teaches transmitting selected wavelength of light (visible light) and reflecting selected wavelength of light (UV light). Thus both references teach the same. Austin's teaching is not limited to sunglasses. Austin also discloses that his invention is useful in providing protection in fields of art and glazing. The Examiner has not conceded that the cited references do not provide motivation. Both Hettich et al and Austin provide general knowledge in optical field. Austin teaches coating each surface of the object. Austin's object such as sunglasses is a complex shaped object. Hettich et al's reflector can also have various shapes.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1773

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. S. Nakarani/af
October 29, 2004


D. S. NAKARANI
PRIMARY EXAMINER